

REMARKS/ARGUMENTS

Claims 1-36 stand rejected in the outstanding Official Action. Claims 5, 12, 17, 24, 29 and 36 have been cancelled without prejudice and claims 1, 13 and 25 amended. Therefore, claims 1-4, 6-11, 13-16, 18-23, 25-28 and 30-35 are the only claims remaining in this application.

The Examiner's acknowledgment of acceptance of Applicant's previously submitted formal drawings is very much appreciated.

Claim 25 is objected to with respect to typographical errors in the words "downloader" and "reporter." Claim 25 has been amended as suggested by the Examiner, thereby obviating any further objection thereto.

Claims 1-36 stand rejected under 35 USC §103 as unpatentable over McCormick (U.S. Patent 6,421,709) in view of Horvitz (U.S. Patent 6,161,130). Claims 1, 13 and 25 have been amended to include the features of cancelled claims 5, 17 and 29, respectively. That feature is that when a received e-mail message is identified as a potentially unwanted e-mail message, it is forwarded to the addressee along with a prompt for the addressee to provide feedback to indicate whether or not the message is an unwanted e-mail message.

In a preferred embodiment, the prompt allows the addressee to identify an e-mail message as unwanted and thereby updating the filter data to identify new unwanted e-mail messages. Notwithstanding the Examiner's allegation that McCormick discloses the subject matter of remaining independent claims 1, 9, 13, 21, 25 and 33, such is not

believed to be the case. As currently amended, all of these claims specify that an incoming e-mail message which is identified as a potentially unwanted message is still forwarded to the addressee. However, the e-mail is forwarded with a prompt for the addressee to provide feedback as to whether the e-mail is really an unwanted e-mail message.

The McCormick patent discloses a different strategy and uses what it calls a “collaborative filter” technique. McCormick uses its filters to either classify an e-mail message as definitely spam in which case it’s discarded, or definitely legitimate in which case it’s passed through to the user’s inbox. However, in McCormick, received e-mail which falls into neither of the above categories, i.e., not definitely spam and not definitely legitimate, is placed into a “waiting room” that is part of the user’s client interface (shown in Figure 2). At this point the user then either moves the e-mail from the waiting room into the inbox for reading or classifies the e-mail as spam by adding them to the no admittance list.

There appears to be no disclosure or suggestion in McCormick of forwarding potentially unwanted e-mail messages to their addressee or accompanying such forwarded e-mail messages with a prompt for the addressee to provide feedback as to whether or not the e-mail message is an unwanted e-mail message.

The difference between McCormick and the presently claimed invention is that McCormick must use a special client user interface/program as shown in Figure 2 in order to differentiate between potential span and non-spam. While this user interface also

provides a feedback mechanism in the form of button 58 and button 60, there is no disclosure of adding a prompt to the e-mail message itself.

While McCormick requires the special client user interface, the present invention requires no such special interface. Because the prompt in the present system becomes a property of the e-mail message itself rather than a function of the ultimate client and his particular user interface program, the present invention would be operable with multiple different e-mail clients. Even with different clients, since the e-mail messages themselves carry the prompt payload, then the feedback mechanism is still operable and effective.

Applicant's original claim 29 dependent on claim 25 recited the "prompt" addition to the e-mail feature and has now been incorporated into independent claim 25. In addressing his rejection of claim 29, the Examiner suggests that McCormick/Horvitz discloses "a received e-mail message identified as a potentially unwanted e-mail message is forwarded to its addressee together with a prompt for the addressee to provide feedback as to whether or not the received e-mail message is an unwanted e-mail message" with the Examiner citing McCormick at column 5, line 10 through column 6, line 28.

However, the designated portion of McCormick merely recites that unknown e-mails not automatically categorized as being on the no admittance list 52 or the guest list 54 are automatically sent to the waiting room folder 20. There is no indication that potentially unwanted e-mail messages are simply forwarded to the addressee but with a prompt added so that an unwanted e-mail message can be designated by the addressee as

such. Thus, the Examiner's cited portion of the McCormick patent fails to teach the claimed feature which has been added to claims 1, 13 and 25 and which was previously present in independent claims 9, 21 and 33. As a result, the McCormick patent fails to support any obviousness rejection of these independent claims or claims dependent thereon under 35 USC §103.

While the Examiner cites Horvitz in his combination of references obviousness rejection under 35 USC §103, there is no indication as to anything being disclosed in any portion of the Horvitz reference, save for the Examiner's general statement "Horvitz, in the same email-messaging endeavor, discloses downloading files, from a remote server, to updating filter software."

There is no allegation that Horvitz teaches adding a prompt to potentially unwanted e-mail that is delivered to the addressee as recited by Applicant's independent claims. Because neither McCormick nor Horvitz discloses this claimed aspect of Applicant's invention, even if McCormick and Horvitz were combined as suggested by the Examiner, they could not render obvious Applicant's independent claims.

Moreover, the burden is on the Examiner to establish a *prima facie* case of obviousness and in order to meet that burden he is required to show reasons or motivations for combining the references. Neither of the references are alleged to contain any such motivation, and in fact they would appear to teach away from the combination of features set out in Applicant's independent claims. Accordingly, any further rejection of

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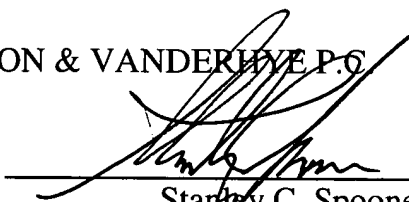
the independent claims or claims dependent thereon over the McCormick/Horvitz combination is respectfully traversed.

Having responded to all objections and rejections set forth in the outstanding Official Action, it is submitted that remaining claims 1-4, 6-11, 13-16, 18-23, 25-28 and 30-35 are in condition for allowance and notice to that effect is respectfully solicited. In the event the Examiner is of the opinion that a brief telephone or personal interview will facilitate allowance of one or more of the above claims, he is respectfully requested to contact Applicant's undersigned representative.

Respectfully submitted,

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